UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,989	10/12/2001	Judith Lee Gardner	29248/AP01949	3346

4743 7590 05/18/2005

MARSHALL, GERSTEIN & BORUN LLP
233 S. WACKER DRIVE, SUITE 6300
SEARS TOWER
CHICAGO, IL 60606

EXAMINER	
BROADHEAD, BRIAN J	

ART UNIT	PAPER NUMBER
3661	

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/976,989
Filing Date: October 12, 2001
Appellant(s): GARDNER ET AL.

Anthony G. Sitko
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 14, 2005.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1 through 41 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,249,720	KUBOTA ET AL.	6-2001
5,797,134	MCMILLAN ET AL.	8-1998

6,487,500 LEMELSON ET AL. 11-2002

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3 through 22, and 24 through 41 are rejected under 35 U.S.C. 102(e). This rejection is set forth in a prior Office Action, mailed on November 12, 2004.

Claim 2 is rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on November 12, 2004.

Claim 23 is rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on November 12, 2004.

Claim 40 is rejected under 35 U.S.C. 112, first paragraph. This rejection is set forth in a prior Office Action, mailed on November 12, 2004.

(11) Response to Argument

Appellant's arguments are not persuasive. Appellant begins by stating on page 5 of the brief "*Kubota does not disclose any consideration of known good practices because Kubota does not disclose any qualitative or objective measurement of driving performance.*" It is difficult to assign any weight to this statement since known good practices are neither claimed nor disclosed in the specification as requiring "qualitative or objective measurement." Appellant tries to give meaning to this qualitative and objective measurement by reciting a narrow example of turning on wet pavement. But once again, qualitative or objective standards are not part of the limitations in the claims or disclosed in the specification and it is impossible to determine the scope of what is meant by those terms.

It is helpful to look to the specification to determine exactly what meaning should be given to known good practices. On the bottom of page 5 through the top of page 6 of the specification, it is stated "the performance may be compared with accepted good practices, and a report may be provided to the operator indicating how the operator's performance compares with accepted good practices and/or with the operator's previous driving performance and/or habitual behavior." In light of this disclosure of how the driver performance is assessed, the limitation of claim 1 of "know good practices" is interpreted as being one of the accepted good practices, operator's previous driving performance, and habitual behavior. This view is further bolstered by Appellant's own claim 40 which recited before the amendment of August 26, 2004, "*known good practices comprises information on driving performance of a normal population, previous driving performance, or habitual behavior.*"

The cited reference of Kubota et al. discloses subject matter that reads on this interpretation of "known good practices". Kubota et al. discloses an invention that includes an agent that provides feedback to the driver of a vehicle based on the current status of the vehicle and the driver. In particular, Kubota et al. discloses on lines 10-28, on column 9, that the agent figure will stumble and fall when the driver brakes harder than what would be considered normal. The agent also takes into account the driver's past performance and if the driver has a habit of braking harder than what is considered normal it will learn to ignore the hard braking and not fall over. Hence, the assessment starts with a normal base rating and changes as the habit of the driver is taken into

consideration. This meets the limitation of "known good practices" as the term is interpreted from the specification.

Appellant further argues that this disclosure by Kubota et al. fails to indicate whether the driver's action is appropriate for the driving situation relative to an objective standard but, once again, this is not what is claimed. Based on the broadest reasonable interpretation of the claim language Kubota et al. reads on the invention. Appellant also argues that Kubota et al. may actually teach away from known good practices. But this argument is not convincing because of the definition given to the term known good practices by the specification. Appellant comments on the merits of the system disclosed by Kubota et al. and gives examples of instances where it might not work as intended. These examples are interesting but not very relevant because they do not show how the claimed invention differs from the prior art.

The Appellant also addresses my argument made in the Final Office action of November 12, 2004. In that argument, much like above, I pointed out that Appellant's own claims had defined known good practices as comprising information on driving performance of a normal population, previous driving performance, or habitual behavior. Appellant's response to that is "habitual behavior alone is not equivalent to known good practices, but may be considered along with other factors in determining know good practiced(sic)." I respectfully disagree with that statement. In writing a limitation of the form x comprises a, b, or c; x can take on any single one of a, b, or c, and not require other factors. Appellant's own specification also uses "and/or" between driving performance of a normal population (accepted good practices), previous driving

performance, and habitual behavior, on the top of page 6. This is interpreted to mean that not all of the factors are required, but any one or combination more than of the factors meet the definition of "known good factors".

The argument with respect to claims 2 and 23 also deals with what meaning to give "known good practices" and those limitations are recited as set forth above.

Appellant's final argument deals with the new matter rejection. Appellant points to page 13 of the specification for support for his amendment. While the specification does mention "good habits", this does not translate into disclosing good habitual driving behavior. An example of a good habit can using your turn signal, habitual behavior is a measure of a driver always using their turn signal. There is a strong difference. The specification seems to be using "good habit" as a synonym for "know good practice". The "driver's normal practice" mentioned later in the paragraph is more synonymous with the "habitual behavior" in the claim. There is not a "good" modifier associated with the disclosure of "driver's normal practice" in this section of the specification. Appellant's argument that the "good" of "known good practices" imputes good onto habitual behavior and previous driving is also not convincing. If that is what was meant when the specification was written then that is what would have been written. The words should be given their plain meaning.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

THOMAS G. BLACK
SUPERVISORY PATENT EXAMINER
GROUP 3600

BJB
May 12, 2005

Conferees
Yonel Beaulieu
Thomas Black

MARSHALL, GERSTEIN & BORUN
6300 SEARS TOWER
233 SOUTH WACKER
CHICAGO, IL 60606-6357